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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,706	08/22/2001	Satoshi Osuga	040894-5698	6235
9629	7590	02/23/2004	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	
DATE MAILED: 02/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,706

Applicant(s)

OSUGA ET AL.

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |



DETAILED ACTION

1. This Office action acknowledges the applicant's Amendment B, presented as Paper No. 8. Claims 1-8 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

3. All claims are now directed to the subject matter constructively elected by original presentation. Therefore, the restriction requirement is no longer required.

Drawings

4. The drawings were received on July 7, 2003. These drawings are acceptable.

Claim Rejections - 35 USC § 102

5. Claims 1, 3, 4, 6, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Baum et al (US 3,212,632).

Regarding claim 1, Baum et al discloses stick-type connected nails (10) with a plurality of nails (12) arranged in a parallel and an equidistant manner (as shown, Figure 1), with connecting bands (18) glued to a shaft portion (16) of nails (12) substantially near the upper end and lower end (as shown, Figure 1). The superposition of the connected nails to another sheet of connected nails is deemed an intended use, it has

been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Baum et al is capable of functioning as claimed by the applicant.

As to claim 3, connecting bands (18) are made of resin (Col. 3, ll. 43-45).

As to claim 4, connecting bands (18) are provided on both sides (22) of shaft portions (16) of nails (12) substantially near the upper end and lower end of the shaft portions (as shown, Figures 2 and 3).

Regarding claims 6 and 7, Baum et al discloses stick-type connected nails (80) with a plurality of nails (12) arranged in a parallel and an equidistant manner (as shown, Figures 9 and 10), with connecting bands (82, 84) glued to a shaft portion (16) of nails (12) substantially near the upper end and lower end (as shown, Figures 9 and 10). Referring to Figure 9 and numbering nails (12) from left to right as numbers 1-8, nails 1, 3, 5, and 7 are arranged as claimed by the applicant in claim 6, and nails 2, 4, 6, and 8 are arranged as claimed by the applicant in claim 7.

As to claim 8, the placement of the connected nails to another sheet such that the lower ends of the shaft portions contact the lower bands of the other sheet of nails is deemed an intended use, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Baum et al is capable of functioning as claimed by the applicant.

6. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Gmeiner (DE 296 17 764 U1).

Regarding claim 1, Gmeiner discloses stick-type connected nails (1) with a plurality of nails (3) arranged in a parallel and an equidistant manner (as shown, Figure 1), with connecting bands (2) glued to a shaft portion (9) of nails (3) substantially near the upper end and lower end (as shown, Figure 1). The superposition of the connected nails to another sheet of connected nails is deemed an intended use, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Gmeiner is capable of functioning as claimed by the applicant.

As to claims 2 and 3, Gmeiner discloses connecting bands (2) made of paper or plastic resin (Page 2).

As to claim 4, Gmeiner discloses connecting bands (2) disposed on both sides of shaft portions (9) of nails (3) substantially near the upper end and lower end of the shaft portions (as shown, Figure 1, and described, Page 2).

Claim Rejections - 35 USC § 103

7. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Signode Corporation (EP 0 053 828 A1) in view of Baum et al.



Regarding claim 1, Signode discloses stick-type connected nails (Figure 13B) with a plurality of nails (19) arranged in a parallel and an equidistant manner (as shown, Figure 13B), with connecting bands (22, 302) connected to a shaft portion of nails (19) substantially near upper end and lower end (as shown, Figure 13B). Signode meets all limitations claimed by the applicant except:

Signode does not disclose connecting bands (22, 302) glued to nails (19).

Baum et al discloses connecting bands (18) glued to nails (12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to glue the connecting bands of Signode to the nails as taught by Baum et al to limit movement of the nails with respect to the connecting bands during handling and transport.

The superposition of the connected nails to another sheet of connected nails is deemed an intended use, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Signode-Baum is capable of functioning as claimed by the applicant.

As to claim 5, Signode discloses connecting band (22) substantially near the upper end of the shaft portion of nails (19) provided on both sides of the nails, and connecting band (302) substantially near the lower end of the shaft portion of nails (19) provided on one side of the nails.

Response to Arguments

8. Applicant's arguments filed December 24, 2003 have been fully considered but they are not persuasive. As detailed above, the references of record disclose, teach, or suggest all features claimed by the applicant.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

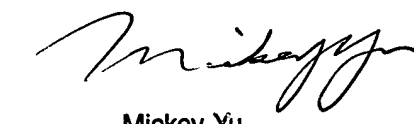
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APP
Greg Pickett
Examiner
February 11, 2004


Mickey Yu
Supervisory Patent Examiner
Group 3700